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EXAMINER

WARE, DEBORAH K

ART UNIT PAPER NUMBER

1651

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/964,077

Applicant(s)
Daffunchio et al.

Examiner
Deborah Ware

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1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 18, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Claims 1-22 are pending.

The election filed January 21, 2003 and amendment therewith as well as the supplemental amendment of March 18, 2003, have all been received and entered of record. Further, the arguments presented have been deemed persuasive in light of the supplemental amendment filed March 18, 2003. Therefore, the restriction requirement of December 17, 2002, has been reconsidered in view of all of the amendments and Applicants' arguments of the election of January 21, 2003, wherein they elected with traverse Group I, claims 1-18. However, they have added two new claims 21-22 and thus, claims 1-22 will be examined on the merits since Applicants arguments to the restriction requirement have been deemed persuasive.

1. The disclosure is objected to because of the following informalities: misspellings, such as "milch" at page 3, last line in specification and because there are no page numbers.

Appropriate correction is required.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3 and 6-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a wasp species of the sub-order Apocrytae which is species *Polybia scutellaris*, does not reasonably provide enablement for any and all wasps as a biocontrol agent of flies in any given area because only some wasps are parasitoids and predatory. The specification does not enable any person skilled in the art to which it pertains, or

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with which it is most nearly connected, to practice and carry out the invention commensurate in scope with these claims. The specification does not enable any other kind of wasp, other than *Polybia scutellaris* of sub-order Apocrytae as being useful for the biocontrol of flies. One of skill in the art would have to undergo extensive experimentation in order to practice and carry out the claimed invention in any area using any kind of wasp with the expectation of success. The level of experimentation is thus undue to one of ordinary skill in the art because of the level of unpredictability in this art. All of Applicants examples are limited to the species as set forth above, and thus, each of the independent claims should be so limited as well in accordance with the teachings of the instantly filed specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 is rendered vague and indefinite for "the biocontrol" at line 1, wherein the phrase lacks antecedent basis and this "the" should be deleted. Also "the approximate population density" and "the fly" as recited in line 3 both lack antecedent basis. Thus, it is suggested to change "the" before "approximate" to --an-- and to change "the" before "fly" to --a--. Further, the term "honeycomb-like" is unclear in that it is uncertain whether or not the device so described in

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the claim is honeycomb or not? First the claims describe "honeycomb devices" then the claim refers to these device as being "honeycomb-like" thus, it is confusing what Applicants' device as so described really appears to be in the claim. It is suggested to change "wherein each honeycomb-like device" to --wherein each said honeycomb device-- . Also at bridging lines 5-6, the phrase "the number of devices" lacks antecedent basis and should be changed to --the number of honeycomb devices--. Furthermore, "the extension" and "the fly activity area" both lack antecedent basis too. The first should be --an extension-- and the second should be --the target fly activity area--. Also the second occurrence of "the extension" should be changed to --an extension--. Further, the second occurrence of "the fly activity area" at line 7 should be changed to --the target fly activity area--. Furthermore, step iv is unclear in that wording of the phraseology is grammatically indefinite. The step should be changed as follows: --iv. placing a food compound that is attractive to wasps within each said wasp activity area--.

7. Claim 2 is unclear whether or not the target flies can be selected from beyond the laundry list of flies in the claim. Do Applicants intend to say "comprising" in place of "consisting"? The metes and bounds of the claim can not be ascertained.

8. Claim 4 does not appear to be properly dependent upon claim 2, since it is not a claim which further limits claim 2 per SE but more directly further limits claim 1. Perhaps Applicants intend for claim 4 to depend from claim 1. For example, "the wasp" of claim 4 is not part of the Group or Markush Group if claim 2 is intended to read as a Markush Group, however, that is uncertain. Also "the sub-order" lacks antecedent basis, and so does "the species" in claim 5.

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9. Claim 6 lacks antecedent basis for "the fly activity area" wherein it should be changed to -the target fly activity area-- . Further "a number of " should be placed before "wasps" at line 3.

Also "wasps honeycomb device" lacks antecedent basis and it is suggested to change it to --of the honeycomb devices-- and also "an area" is unclear as to what type of area does it define, "a target area" or "wasp activity area" or what. The metes and bounds of the claim can not be determined, per se.

10. Claims 7-8 also lack antecedent basis for "the fly activity area" recited at line 1. Similar changes as discussed for claim 6 should also be considered for these claims for the same reasons as discussed above.

11. Claim 10 is rendered vague and indefinite for the recitation of "any site selected from the group comprising a ...cattle feeding place" since the metes and bounds of the claim can not be determined. It is unclear what other sites may be included or intended by the language used in the claim.

12. Claim 11 is rendered confusing and awkward for the recitation of "is placed for the wasps" and should be deleted for clarity. Also after "food" at line 2, --and-- should be placed before "is placed". Also "from each honeycomb device" at line 2 should be changed to --from each of the honeycomb devices-- .

13. Claim 14 is rendered vague and indefinite for the recitation of "human livings" wherein it is uncertain what this term means. Does the term refer to human beings? The metes and bounds of the claims can not be ascertained. Further the recitation of the language "from the group

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comprising and any breeding animal" is indefinite for the what group intends to define.

Again the metes and bounds of the claim can not be determined.

14. Claim 16 lacks antecedent basis for "the shade" at line 2.

15. Claim 18 is rendered vague and indefinite for the recitation of "desired location" wherein it is uncertain whether such location is still in "the target fly activity" when "fixing the tree portion" is involved.

16. Claim 19 is rendered vague and indefinite for the recitation of "by any mammalian" wherein the phrase makes the claim grammatically indefinite. It is suggested to change the term to --by a mammal--.

17. Further, claim 20 is rendered vague and indefinite for the recitation of "containing wasp" at recited at line 2 of claim 20. Also the claim is rendered indefinite for the recitations such as "fly activity area" and "desired wasps activity area" for reasons discussed above for similar language used in preceding claims. Claim language should be consistent and clear in all of the claim.

18. Claims 21-22 are rendered vague and indefinite for the recitation of various terms and phrases used in preceding claims of which said rejections for these terms are discussed *supra*, such as "attractive of wasps" at line 4, and "by any mammalian" at line 6 for claim 21, and lines 7 and 9 for claim.

19. Claim 12 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the

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claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim 12 does not limit claim 11, because a honey-containing food is already described by claim 11.

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

21. Claims 1-3, 12, 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alston (nonpatent reference cited on enclosed PTO-892 Form-published in 1996) in view of Roberts (A, also cited on enclosed PTO-892 Form) and admitted prior art, note page 7 of the instantly filed specification.

Claims are drawn to methods and system for biocontrol of flies using wasps contained in a honeycomb or hive taken from a tree and fixed in shade in a selected area where target pests,

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the flies, are located and basing the number of wasps added according to the flies in the area.

Also a food compound such as honey is added to attract the wasps to an activity area.

Alston teaches wasps useful as predators and parasitoids. Furthermore, Alston teaches pest management using activity of one species to reduce the effect of another for biocontrol. The reference clearly teaches introducing an insect into a selected area (target area) while determining or gaining knowledge of the number of target pests in the area before placing a number of biocontrol agents (i.e. wasps) into another area (point of introduction or placement) and further the use of a food compound as a part of the biocontrol process for increasing the fitness of the biocontrol agent (i.e. wasps). Note pages 1, all lines, and see graph and also note page 3, lines 4-25. Target pests such as flies are clearly disclosed and biocontrol agents such as wasps are clearly disclosed as well.

Roberts teaches desired sites for biocontrol include locations where animals and people may be such as barns, sheds, feed lots, pens and the like, note col. 1, lines 9-11.

Admitted prior art clearly teaches that of recent years wasps have been used as biocontrol for flies, note page 7 of the instant specification, lines 3-8.

The claims differ from the disclosure in that a honeycomb or hive taken from or a part of a tree, placed in shade, useful against a house fly in areas occupied by animals and/or humans is not specifically disclosed.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the teachings of Alston, Roberts and the admitted prior art at

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page 7 of the instant specification to provide for a method and system for biocontrol pitting wasps against flies. To select desired sites such as cattle feed lots, etc. is clearly taught by Roberts and within the skill of an ordinary artisan. Thus, whether using organic chemicals or insecta biocontrol in a feedlot is clearly an obvious modification and one of skill would have expected successful results for the selection of wasps against flies, such as the house fly. To select the house fly, which is a most common fly is clearly within the skill of an ordinary artisan. Further, Alston clearly teaches using a food source to enhance survival of the biocontrol agent and also teaches wasps to be useful as biocontrol agents. The admitted art clearly provides the elements of using wasps against flies and Alston clearly teaches the process steps and system as claimed herein.

Since Alston also clearly teaches the food source, honeycomb useful as the source of honey and device would have clearly been an obvious modification. Wasps are well known to be found in honeycomb or hives which contain the wasps which are known to be attracted to honey. Honey is an expected byproduct of the honeycomb or hive. Further, hives or honeycomb are found in trees and wasps prefer shade which is a well known characteristic. One of skill in the art would have been motivated by the cited prior art to provide for a method and system for biocontrol as claimed herein. Each of the process steps and components of the system: the hive and honey, are taught, or at least suggested, by the cited prior art.

One of skill in the art would have expected successful results based upon the teachings of the prior art. Any type of fly such as a horn fly or house fly would have been expected to be

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biocontrolled by wasps as the admitted prior art and Alston clearly teach biocontrol. Roberts clearly teaches fly activity areas to include areas occupied by humans and animals. Wasps prefer shady areas for placement of their hive and often build them in the shadow of trees, etc.

Therefore, to provide for a tree cutting containing a natural hive is clearly within the skill of the ordinary artisan. This would be an obvious source for locating the biocontrol agent in a method and system for biocontrol of flies. Wasps are attracted to honey and this is well known, of which Alston clearly addresses the need for a food source. Wasps prefer to be near a food source as do most insects. The claims are prima facie obvious over the cited prior art.

22. The art rejected claims fail to be patentably distinguishable over the state of the art discussed above and cited on the enclosed PTO-892 and/or PTO-1449. Therefore, the claims are properly rejected.

The remaining references listed on the enclosed PTO-892 and/or PTO-1449 are cited to further show the state of the art.

No claims are allowed.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is (703) 308-4245. The examiner can normally be reached on Mondays to Fridays from 9:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Deborah K. Ware
DEBORAH K. WARE
PATENT EXAMINER
Deborah K. Ware

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May 31, 2003